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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,834	04/03/2001	Robert S. Persky	10663-1US	2749

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/824,834

Applicant(s)

PERSKY, ROBERT S.

Examiner

Yehdega Retta

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5, 10, 17-20, 22-27, 39-42 and 44 are rejected under 35 U.S.C. 102(a) as being anticipated by John Hagel III et al. “Net Worth” (hereinafter Hagel) .

Regarding claims 1-3, Hagel teaches electronically soliciting individuals to agree to predetermined of conditions regarding the provision and handling of personal data, receiving agreement; soliciting the individuals for personal data and determining a portion of the revenue and determining on periodic basis whether revenue was received in exchange for the personal data (see page 18-22, 26-37, 40-42, 109-113, 169-173).

Regarding claim 4 and 5, Hagel teaches those who are willing to reveal their identity will stand to profit, they get paid every time they divulge who they are or what the e-mail address is. Hagel further teaches the negotiating the terms of information disclosure and providing mechanism for the release of customer’s information upon payment (see page 38-40). Determining percentage of the questions and determining the portion of the revenue to be credited is inherent to Hagel’s teaching of getting paid more for revealing identity or e-mail address.

Regarding claims 10, 22 and 44, Hagel teaches personal data including at least one of name, telephone number, etc. (see page 110-112).

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Regarding claims 17-20 and 39-42, Hagel teaches electronically soliciting individuals to agree to predetermined of conditions regarding the provision and handling of personal data, receiving agreement; soliciting the individuals for personal data and determining a portion of the revenue and determining on periodic basis whether revenue was received in exchange for the personal data (see page 18-22, 26-37, 40-42, 109-113, 169-173). Hagel teaches those who are willing to reveal their identity will stand to profit, they get paid every time they divulge who they are or what the e-mail address is. Hagel further teaches the negotiating the terms of information disclosure and providing mechanism for the release of customer's information upon payment (see page 38-40). Determining percentage of the questions and determining the portion of the revenue to be credited is inherent to Hagel's teaching of getting paid more for revealing identity or e-mail address.

Claims 23-25 are rejected as stated above in claims 1-3.

Claims 26 and 27 are rejected as sated above in claim 4-5

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9, 11-16, 28-38 and 43, are rejected under 35 U.S.C. 103(a) as being unpatentable over John Hagel III et al. "Net Worth" (hereinafter Hagel) and further in view of Official Notice.

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Regarding claims 6-9, 21 and 43 Hagel teaches electronically soliciting individuals to agree to predetermined of conditions regarding the provision and handling of personal data, receiving agreement; soliciting the individuals for personal data. Hagel does not explicitly teach periodically updating the data. Official Notice is taken that is old and well known in the art of marketing to request individuals to update their data. It would have been obvious to one of ordinary skill in the art at the time of the invention to request individuals to update the personal data in order to keep updated database, which reflects current change (such as martial status or telephone number etc.) for the purpose of providing proper service. Hagel teaches individuals subjected to targeting messages based on the personal data (see page 38-39).

Regarding claims 11, 12 and 14, 33, 34 and 36, Hagel teaches electronically soliciting individuals to agree to predetermined of conditions regarding the provision and handling of personal data, receiving agreement; soliciting the individuals for personal data and determining a portion of the revenue and determining on periodic basis whether revenue was received in exchange for the personal data (see page 18-22, 26-37, 40-42, 109-113, 169-173). Hagel does not explicitly teach periodically updating the data. Official Notice is taken that is old and well known in the art of marketing to request individuals to update their data. It would have been obvious to one of ordinary skill in the art at the time of the invention to request individuals to update their personal data in order to keep updated database, which reflects current change (such as martial status or telephone number etc.) for the purpose of providing proper service.

Regarding claim 13 and 15, 35 and 37, Hagel teaches those who are willing to reveal their identity will stand to profit, they get paid every time they divulge who they

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are or what the e-mail address is. Hagel further teaches the negotiating the terms of information disclosure and providing mechanism for the release of customer's information upon payment (see page 38-40). Determining percentage of the questions and determining the portion of the revenue to be credited is inherent to Hagel's teaching of getting paid more for revealing identity or e-mail address. Hagel teaches individuals subjected to targeting messages based on the personal data (see page 38-39).

Regarding claims 16 and 38, Hagel teaches personal data including at least one of name, telephone number, etc. (see page 110-112).

Claims 28-31 are rejected as stated above in claim 6-9.

Regarding claims 32, Hagel teaches personal data including at least one of name, telephone number, etc. (see page 110-112).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Boe et al. U.S. Patent No. 6236975 teaches profiling customers for targeted marketing.

Schulze U.S. Patent No. 6233564 teaches merchandising using consumer information from survey.

Maggio U.S. Patent No. 6606745 teaches communicating advertisement and entertainment content and gathering consumer information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta
Primary Examiner
Art Unit 3622

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